

Appln. No. 09/506,434
Response to Restriction Requirement dated June 28, 2005
July 28, 2005

REMARKS

Applicants hereby file this Response to the Restriction Requirement mailed on June 28, 2005 ("Restriction Requirement"). Claims 15, 17, 21, 55-58, 64 and 65 are pending and claims 1, 4, 11, 13, 50-54, 59-63, 66 and 67 have been withdrawn. Claims 1, 4, 6, 10, 11, 13, 15, 17, 21 and 50-67 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. *See* Restriction Requirement, ¶ 5. The Examiner has also required restriction to one of three inventions. *See* Restriction Requirement, ¶ 6.

I. Objections to the Specification.

The specification was amended in response to the previous objection that the figure descriptions in the specification are allegedly not in agreement with the drawing labels in the figures. *See* Final Rejection at ¶ 4. Applicants thank the Examiner for withdrawing these objections as overcome by Applicants' amendments. *See* Restriction Requirement, ¶ 2.

II. Rejection under 35 U.S.C. § 112, first paragraph.

Claims 1, 4, 6, 10, 11, 13, 15, 17, 21 and 50-67 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. *See* Restriction Requirement, ¶ 5. The Examiner states that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention . . . [i]t is unclear in the Specification that the ACH and automated banking system do not receive the physical check and this is the reason for the 35 U.S.C. 112, first paragraph rejection." *See* Restriction Requirement, ¶ 5. Applicants respectfully submit that this rejection should be withdrawn because the Examiner has not met the burden of establishing a reasonable basis to question the enablement provided for the claimed invention. *See* MPEP §2164.04, *citing In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). Additionally, Applicants respectfully submit that the Specification, as originally filed, fully enables the subject matter of the rejected claims.

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A. The Examiner Has Failed to Meet the Initial Burden Of Establishing a Reasonable Basis To Question the Enablement Provided For The Claimed Invention.

“A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied upon for enabling support.” *See* MPEP § 2164.04, *citing In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). When a rejection is made on the basis of failing to teach how to make and/or use the subject matter sought to be patented, “it is incumbent upon the Patent Office . . . to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement . . . [o]therwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.” *See* MPEP § 2164.04, *citing Marzocchi*, 439 F.2d at 224, 169 USPQ at 370 (emphasis in original).

In this rejection, the Examiner has not provided any reasoning why a person skilled in the art of automated financial transactions would not be enabled to make and/or use the invention claimed in claims 1, 4, 6, 10, 11, 13, 15, 17, 21 and 50-67, and specifically has not provided any reason why a person of skill in the art would not be enabled by the disclosure to deposit the discrete value of a third party check without physical receipt of the third party check by the ACH and automated banking system. Applicants respectfully submit that the Examiner has not explained why she doubts the truth or accuracy of any statement in the Specification, or backed up her assertions with acceptable evidence or reasoning which is inconsistent with the contested limitation (*i.e.*, that the ACH and automated banking system do not receive the physical check). Further, this rejection fails to “focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.” *See*

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MPEP § 2164.04 (emphasis in original). Additionally, there are no “specific technical reasons” provided in support of this rejection, which are “always required.” *See* MPEP § 2164.04. Accordingly, Applicants respectfully submit that this rejection should be withdrawn for failing to meet the initial burden of showing lack of enablement.

B. The Specification, As Originally Filed, Enables the Claimed Inventions.

Applicants also respectfully submit that the Specification, as filed, enables the contested limitation that the discrete value of a third party check is deposited although the ACH and automated banking system do not receive the physical check, as claimed in claims 1, 4, 6, 10, 11, 13, 15, 17, 21 and 50-67. Specifically, several embodiments in the Specification disclose that the clearing process of the third party check resulting in a credit to the customer account is based on electronic *images* of the third party check or other data that is sent from a remote terminal to the BOFD system, as opposed to receipt of the physical check by the BOFD or ACH.

For example, the Summary of the Invention includes the disclosure of an embodiment where a Remote Customer Terminal (RCT) “accepts” third party paper checks for deposit, the RCT being located at the customer’s home. *See* Specification, p. 3, line 22 to p. 4, line 5. The image of the third party paper check is captured on a scanner, and is forwarded to the BOFD system. *See* Specification, p. 4, lines 8-9. The BOFD provides immediate provisional credit to the customer, and forwards the “*check image and other data*” to a clearing house in the form of an ECP transaction . . . [o]nce the transaction has cleared the paying bank, the BOFD issues a permanent credit to the bank customer.” *See* Specification, p. 4, lines 10-13 (emphasis added). In this embodiment, the customer provides an image and/or data of the third party check, not the physical check itself, to the BOFD to complete the deposit transaction.

Additionally, in the Detailed Description of the Invention, the Specification describes the data flow from both the customer perspective and the bank perspective in an embodiment of the invention. From the customer perspective, the Detailed Description describes an embodiment where the customer enters data into a RCT comprising customer identification, customer account number, name of payor, name and routing number of payor’s bank, the amount of the check, *an image of the check* and other information. *See* Specification, p. 8, lines 9-12. The *data* are submitted to the BOFD for processing. *See* Specification, p. 8, lines 13-15. In this embodiment,

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the deposit transaction does not require that the BOFD or ACH physically receive the third party check.

Additionally, the Specification discloses actions that can be taken to “prevent re-deposit of the same paper check. *See* Specification, p. 8, lines 19-20; original claims 19, 20, 28, 29. One such action is that the paper check may be marked by the RCT or physically captured by the RCT. *See* Specification, p. 8, line 20 to p. 9, line 2. This disclosure of actions taken to prevent re-deposit of the same check confirms that the physical check was *not* presented to the BOFD or ACH for deposit – if the third party check *had* been physically presented to the BOFD or ACH for deposit, then these actions to prevent “re-deposit of the same check” could not be taken. Accordingly, after the third party check has been deposited, these actions insure that the customer, who retains physical possession of the third party paper check, cannot “re-deposit” it.

The description of the data flow from the bank perspective also confirms that the disclosure describes an embodiment where the discrete value of the third party check is deposited without physical receipt of the check by the ACH or automated banking system. In this embodiment, the BOFD receives transaction data from a customer concerning a third party check, and the BOFD may issue credit based upon the data. *See* Specification, p. 9, lines 7-14. This embodiment similarly refers to “actions” to “prevent redeposit of the same check.” *See* Specification, p. 9, lines 14-16. Again, just as discussed, this disclosure of “actions” to prevent re-deposit of the same check confirms that the paper check was *not* presented to the BOFD for deposit – if the third party check *had* been physically presented to the BOFD for deposit, then actions to prevent “re-deposit of the same check” such as physical capture of the check or marking by human or machine-readable ink could not be taken. Further, disclosed methods for “clearing” the third party check likewise confirm that the BOFD does not have physical possession of the paper check. In one such method, the BOFD may “print a reconstructed check” which may be physically routed to the paying bank for payment. *See* Specification, p. 9, line 18 to p. 10, line 7; original claim 24. There is no need to “print a reconstructed check” if the BOFD already has physical possession of the third party check that was deposited by the customer.

Finally, the Specification discusses that EFT and ECP are “existing systems that perform

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electronic banking transactions" but "are either not equipped to handle paper checks, are configured only for bank-to-bank transactions, or do not accept third party checks for deposit." See Specification, p. 2, lines 19-21. For example, EFT transactions "are convenient to the extent that they do not require customers to physically visit the bank in order to initiate a financial transaction" but suffer from the significant disadvantage that "they are not equipped to accept paper checks as part of the transaction." See Specification, p. 1, line 14 to p. 2, line 1. ECP can be used to convert paper checks to electronic transactions but the bank first receives a paper check (bank of first deposit, or BOFD) and captures an electronic image of the check or otherwise convert the check to an electronic transaction for processing through a clearing house and paying bank. See Specification, p. 2, lines 6-10. Thus, the Background of the Invention explains that existing systems cannot be used to allow remote deposit of third party checks *without* physical delivery of the third party check to a BOFD.

Accordingly, Applicants respectfully submit that the Specification as originally filed enables the subject matter claimed in claims 1, 4, 6, 10, 11, 13, 15, 17, 21 and 50-67, and specifically enables one of skill in the art of automated financial transactions to make and/or use the claimed systems and methods for depositing the value of a third party check from a remote location where neither the ACH and automated banking system receive the physical third party check. Applicants therefore respectfully request that this rejection be withdrawn.

III. Election of Claims.

The Examiner stated that restriction to one of the following inventions is required pursuant to 35 U.S.C. § 121:

- I. Claims 1, 4, 11, 13, 50-54 and 60-63, drawn to a system for entering information from a conventional check and effectuating the deposit of a discrete value;
- II. Claims 15, 17, 21, 55-58, 64 and 65, drawn to a method for receiving conventional checks, logging a bank customer onto an automated banking system, entering transaction data, and processing the discrete value of each check deposited; and

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III. Claims 59, 66 and 67, drawn to a method for associating a terminal with a demand deposit account, receiving a request from the bank customer, authorizing the bank customer payee as a user, and receiving the transaction data related to the deposit of a conventional check.

See Restriction Requirement, ¶ 6. Pursuant to 37 C.F.R. 1.142(a), Applicants elect claims 15, 17, 21, 55-58, 64 and 65 of Group II, drawn to a method for receiving conventional checks, logging a bank customer onto an automated banking system, entering transaction data, and processing the discrete value of each check deposited. Claims 1, 4, 11, 13, 50-54, 59-63, 66 and 67 are withdrawn.

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CONCLUSION

Applicants respectfully submit that claims 15, 17, 21, 55-58, 64 and 65 are in condition for allowance and request allowance of the same.

Applicants believe that no fee is due upon the filing of this Response to the Restriction Requirement which has been filed within one (1) month of the date of mailing of the Restriction Requirement. If any fees are determined to be due, the Commissioner is hereby authorized to deduct such fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: July 28, 2005

Hunton & Williams LLP

Intellectual Property Department

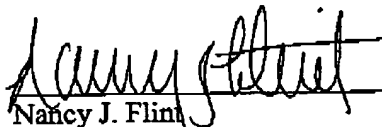
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